

## **REMARKS**

Claims 1, 3-7, 9, 11-19, 21, 23 and 25 remain pending in the application.

### **35 U.S.C. § 103 Rejection:**

Claims 1, 3-7, 9, 11-19, 21, 23 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sartore, U.S. Patent 6,012,103 in view of Clarke, U.S. Patent 4,916,692 and in further view of Murphy, U.S. Patent 5,604,906. Applicant respectfully traverses this rejection.

**There prior art does not suggest the desirability of the claimed combinations of features.** The teachings of Sartore, Clarke, and Murphy are presented in previous office action responses.

Independent claim 1 recites, in pertinent part:

“A method for configuring a peripheral bus, the method comprising ... reading configuration information from the peripheral device, wherein the configuration information includes device identification information, wherein said reading is performed over a serial side bus, wherein the serial side bus is separate from the peripheral bus, wherein the serial side bus is coupled to the host controller and the peripheral device” (Emphasis added).

Independent claim 14 recites a similar combination of features.

The Examiner acknowledges that Sartore in view of Clarke does not expressly disclose the method or computer system where the serial side bus is separate from the peripheral bus, but contends that Murphy discloses where a serial side bus is separate from the peripheral bus (citing Murphy in Fig. 2, item 18). The Examiner then contends that the suggestion or motivation for combining Murphy with Sartore and Clarke “would have been to increase the speed of the system by separating functions performed between

the host controller and peripheral devices” (citing Murphy at Column 4, lines 66-67 and Column 5, lines 1-6). Column 4, line 66 to column 5, line 6 of Murphy states:

“If the controller has a dual bus configuration, where one bus is connected to its internal devices and the external bus 16 is separate, additional speed is made possible by operating the two busses in parallel. For example, read requests can be sent to the internal disk drive or RAM disk over the internal bus at the same time as write commands are being sent to the computer 10 over the external bus.”

Applicant submits that the above citation does not provide a suggestion or motivation to combine Murphy with Sartore and Clarke. In the above citation, Murphy refers to two buses: an external bus (external bus 16) and a bus internal to controller 14. However, serial link 18, as clearly shown in Fig. 2 and Fig. 4 of Murphy, is external to controller 14. Accordingly, it is clear that the above citation is not suggesting any advantage of providing serial link 18, since it only refers to the speed advantage of operating external bus 16 in parallel with an internal bus. Furthermore, Applicant can find no other teaching or suggestion in Murphy or the other cited references that would suggest their combination is desirable, nor has the Examiner provided any other citations showing a suggestion to combine the references other than the alleged suggestion discussed above.

Murphy is “directed to the process of downloading software onto computers, particularly the downloading of pre-bundled software as part of the computer manufacturing process” (Emphasis added; Col.1, lines 8-11 of Murphy). Applicant submits that there is no suggestion of desirability to combine Murphy with the other cited references in order to provide “A method for configuring a peripheral bus ...” including “reading configuration information ... wherein said reading is performed over a serial side bus” as recited in the independent claims. Murphy does not teach or suggest the using the serial link for reading configuration information in a method for configuring a peripheral bus (as noted in the previous office action response), while none of the cited

references, taken singly or in combination, suggest the desirability of using a serial side bus for reading configuration information in a method for configuring a peripheral bus.

The question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 488 (Fed. Cir. 1984). “The factual inquiry whether to combine references must be thorough and searching.” *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). It must be based on objective evidence of record. “This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” *In re Sang Su Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). “The need for specificity pervades this authority.” *Id.* “Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000; Emphasis added). Applicant asserts that the Examiner has not satisfied the rigorous tests for properly combining references to establish obviousness. Instead, as discussed above, the Examiner’s reasoning is not supported by the teachings of the references, lacks specificity, and thus Applicant respectfully submits that it is based in hindsight.

For at least the reasons stated above, Applicant submits that a case of obviousness has not been established. Accordingly, removal of the 35 U.S.C. § 103(a) rejection is respectfully requested.

## CONCLUSION

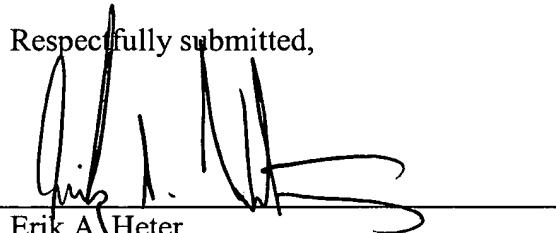
Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5500-58300/BNK.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

Respectfully submitted,



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